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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,460	12/19/2000	Gary R. McLuen	NEI-00105	8839
7590 06/30/2004				
Jonathan O. Owens Haverstock & Ownes LLP 162 North Wolfe Road Sunnyvale, CA 94086			EXAMINER QUAN, ELIZABETH S	
			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/742,460

Applicant(s)

MCLUEN ET AL.

Examiner

Elizabeth Quan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 31-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 31-33, 35-37 are rendered indefinite since it is unclear whether the recitation “engaging a drain associated with a selective one of the first bank of vials and the second bank of vials within a purging system” means engaging a drain associated with one vial selected from each bank of vials or engaging a drain associated with one vial selected from a group of both banks of vials. It is unclear whether the drain is associated with both the first and second bank of vials.

4. Claim 34 is rendered indefinite since it is unclear whether a single drain is associated with both the first vial and second vial or just one of the vials.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 31-33, 35, 39-41 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/10857 to Zuckermann et al.

Zuckermann et al. disclose a method of selectively and sequentially dispensing a plurality of reagent solutions to a plurality of vials (254) divided into a first bank of vials and a second bank of vials and selectively purging material from the first bank of vials and the second bank of vials (figs. 1-5; page 6, lines 16-19; page 3, lines 6-25).

One or more of the plurality of reagent solutions is dispensed to a selective one or more of the plurality of vials to perform synthesis within the selective one or more of the plurality of vials (page 3, lines 6-25; page 13, lines 9, 10, 16-29). Dispensing is performed in a parallel fashion when one or more of the plurality of reagent solutions is dispensed into more than one of the plurality of vials by a multi-channel pipettor (page 3, lines 16-19, 26, 27; page 14, lines 3-7). Dispensing is also performed in a serial fashion since reagent solutions are added step-wise to each of the vials (page 6, lines 16-19).

A drain (258,260) associated with a selective one of the first bank of vials and the second bank of vials is engaged within a purging system (fig. 5; page 14, line 11-page 15, line 10). A rack (252) contains a plurality of linear arrays of vials in which all of the barrel drains in each linear array are individually actuated by an actuation means (256) coupled to that array (fig. 5; page 14, lines 16-18). The rack can be placed on a vacuum manifold (258), which has means (260) for connecting the manifold with a vacuum source (fig. 5; page 14, lines 18-21). The vacuum manifold is evacuated to provide a vacuum under the vials contained within the rack to facilitate draining of the vials (page 14, lines 21-29). The vacuum forms a pressure differential

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between an interior and exterior of selective one of the first bank of vials and second bank of vials to expel material from the selective one of the first bank of vials and second bank of vials.

Material is purged from the selected one of the first bank of vials and the second bank of vials through the purging system (figs. 1-5). A matrix of vials is formed by a plurality of substantially parallel linear arrays of modular vials in which the vials in each discrete linear array of vials in the matrix can be actuated in tandem to the exclusion of vials in other linear arrays by operation of an actuation means (228) to simultaneously actuate the barrel drains (220) associated with each of the vials in the linear array (figs. 1-5; page 3, lines 22-25). When the rack with the linear arrays of vials is placed on the manifold in a vacuum-tight relation and evacuated to provide a vacuum under the vials and form a pressure differential between an interior and exterior of the vials and actuation means (256) is operated, the barrel drains in each of the vials are opened to drain materials into the vacuum manifold for collection by a waste receptacle (fig. 5; page 14, lines 23-29).

7. Claims 34, 42, 43 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,053,454 to Judd.

Judd discloses a method of selectively purging material from a selective one of a first and second vial in which synthesis is taking place (col. 3, lines 31-37). A drain associated with the selected one of the first vial and second vial is engaged or coupled with a waste tube when the associated stopcock (11) is opened. According to <http://www.m-w.com>, engage is defined as to become involved in and couple is defined as to connect. The stopcock provides fluid connection between the drain of the vial with the waste tube connected to the vacuum source when open. When the vacuum pump is turned on and the selected stopcock is opened, materials will be

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purged from the vial associated with the selected stopcock. The waste tube is considered to be disengaged from the drain after material is purged when the stopcock is closed.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 34, 36-38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/10857 to Zuckermann et al. in view of U.S. Patent No. 6,083,682 to Campbell et al. and/or U.S. Patent No. 5,053,454 to Judd and/or U.S. Patent No. 5,792,430 to Hamper.

Zuckermann et al. disclose a plurality of first vials in a first linear array and a plurality of second vials in a different second linear array. Zuckermann et al. do not show the drain attached to the vacuum source. Each of Campbell et al., Judd, and Hamper has been cited to show that the vacuum source is a tubular structure that connects with a hose or other tube, such as means (260) of Zuckermann et al., to facilitate the draining process. The vacuum source is considered a waste tube since it is in the form of a tubular structure and facilitates the draining of wastes. Campbell et al. disclose means (52) connecting with a waste tube off the top of container (44) that provides a vacuum for draining the vials. Judd discloses means (38) connecting with a waste tube (40) that is probably connected to another tube off the top of flask (42) that is connected to a vacuum pump (44) to facilitate draining the vials. Hamper shows a tubular port connected to a hose (28a), which is connected to a tubular structure off the top of the waste trap (29), which is connected to a hose (28b) to a vacuum pump. Each of Campbell et al., Judd, and Hamper show that is well known to engage a drain with a vacuum waste tube to facilitate draining of wastes. It is also well known to disengage the vacuum waste tube from the drain

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after the material has been purged to clean the equipment and reuse the vacuum waste tube with the same or different equipment in attempting the same or different processes to be economical. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Zuckermann et al. to engage a drain with a waste tube to efficiently drain wastes and disengage a drain with a waste tube to reuse the waste tube with the same or different equipment in attempting the same or different processes to be economical as taught by Campbell et al. and/or Judd and/or Hamper.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 31-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (571) 272-1261. The examiner can normally be reached on M-F (8:00-4:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth Quan  
Examiner  
Art Unit 1743

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Jill Warden  
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